

REMARKS

Summary of the Office Action

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi et al. (U.S. Patent No. 5,815,486) (hereinafter "Kobayashi") in view of Ota (U.S. Patent No. 5,559,784) (hereinafter "Ota").

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi and Ota as applied to claim 10 above, and further in view of Maeda et al. (U.S. Patent No. 5,808,988) (hereinafter "Maeda").

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi and Ota as applied to claim 10 above, and further in view of Masui (JP 2000/339694 A) (hereinafter "Masui").

Claim 14 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Claims 10-14 have been amended to differently describe embodiments of the disclosure of the instant application. Accordingly, claims 1-14 remain pending and under consideration.

Rejections under 35 U.S.C. § 103(a)

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Ota. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Kobayashi and Ota as applied to claim 10 above, and further in view of Maeda. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi and Ota as applied to claim 10 above, and further in view of Masui. Applicant has amended claims 10-14 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claim as newly-amended, they are respectfully traversed for at least the following reasons.

Independent claim 10 has been newly-amended to recite a recording apparatus combination that includes "a circuit for generating a recording mark signal for recording a recording mark of a predetermined length, which reduces a difference in reflectance between said information rewritable regions and said pre-pit region, in each of said pre-pit region while the beam of light is irradiated on the pre-pit region."

Kobayashi discloses an optical disk in which pre-information is recorded in the wobbled groove. Applicant respectfully submits that this disclosed arrangement of Kobayashi is clearly different from embodiments of the disclosure of the instant application which relate to an optical disk having pre-pits. More specifically, Applicant respectfully submits that Kobayashi merely discloses that data is recorded on the wobbled pre-groove, and clearly fails to disclose at least the feature that a recording mark that reduces the difference in reflectance is recorded in the pre-pit area. Furthermore, Applicant respectfully submits that Kobayashi does not include any description about a difference in reflectance between the wobbled groove and another groove or track. In addition, the Examiner acknowledges, at page 5 of the Final Office Action that "Kobayashi et al. do not disclose the claimed property 'average reflectance of said rewritable regions is different from average reflectance of said pre-pit regions.'" However, the Final Office

Action then applies Ota as allegedly curing the deficiencies of Kobayashi. To the extent that this assertion might be maintained even in light of the concurrently-filed amendments to claim 10, this interpretation is respectfully traversed for at least the following reasons.

Ota differs from the features of newly-amended claim 10 in that it discloses an optical recording medium in which information is recorded by creating a difference in transmittivity of light, refractive index, plane of polarization, and so on between the recording pits and the surrounding area. However, Applicant respectfully submits that Ota clearly fails to disclose or suggest at least the feature of forming a recording mark in order to reduce the change in amount of leakage light that is produced by the difference in reflectance between the pre-pit region and rewritable regions.

Accordingly, even assuming, strictly arguendo, that the Office Action's combination of Kobayashi and Ota could be made, particular features of independent claim 10 would still not be shown or suggested by the combination.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because none of the applied references of record, whether taken singly or combined, teach or suggest each feature of newly-amended independent claim 10. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicant respectfully asserts that the dependent claims 11-13 are allowable at least because of their dependence from claim 10, and the reasons set forth above. Moreover, with regard to the rejections of dependent claims 11-13 under 35 U.S.C. § 103(a), Applicant

respectfully submits that the additionally applied references to Maeda and Masui do not cure the deficiencies of Kobayashi and Ota, as discussed above. Accordingly, withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

The Examiner is thanked for the indication that claim 14, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form. However, in light of the foregoing discussion, Applicant respectfully submits that claim 14 is in condition for allowance at least because of its dependence on independent claim 10, and the reasons set forth above. Accordingly, withdrawal of the objection to claim 14 is respectfully requested.

CONCLUSION

In view of the foregoing, Applicant submits that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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